



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masahiro MACHIDA et al.

Group Art Unit: 2174

Application No.: 09/810,534

Examiner: P. KE

Filed: March 19, 2001

Docket No.: 108973

For: OPERATING METHOD AND DEVICE, AND IMAGE PROCESSING APPARATUS
USING THE SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Extension of Time. Review of the June 25, 2008 Office Action is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believes that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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Date: October 27, 2008

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**REMARKS**

Claims 1, 3-7 and 9-22 are pending.

I. Rejection of Claims 1, 4-7, 10-4, 16-18 and 20-22

The Office Action rejects claims 1, 4-7, 10-4, 16-18 and 20-22 under 35 U.S.C. §103(a) over U.S. Patent No. 6,181,893 to Collard et al. (hereinafter "Collard") in view of U.S. Patent No. 6,115,720 to Bleizeffer (hereinafter "Bleizeffer"). Appellants respectfully disagree and assert that a *prima facie* case of obviousness has not been established.

Independent claims 1, 7, 13, 14, 16, 18, 20 and 22 each recite, *inter alia*, that (1) an item which has been already set, (2) an item which is being set along with parameters to choose from, and (3) an item which has not yet been set are displayed in the single frame of the display device so as to be distinguishable from one another.

As shown in Appellants' Fig. 5, for example, the menu item button 126₁ displays a parameter display window 127₁ indicating a parameter that has already been set. The menu item button 126₂ displays a blank parameter display window 127₂ because the parameters for the button 126₂ is being set by the user. The menu item buttons 126₃-126₅ are indicated with dotted lines without any parameter display windows because the parameters have not yet been set by the user. Therefore, the user can easily recognize which item has been set, which item is being set, and which item has not yet been set by the user.

The Office Action alleges that Collard discloses an item which has been already set, an item which is being set along with parameters to choose from, and an item which has not yet been set are displayed in the single frame so that the item that is being set is distinguishable from the item which has been already set and the item which has not yet been set. The Office Action asserts that the "Basic Settings" shown in Fig. 4 of Collard are displayed differently from the rest of the items and correspond to the claimed feature.

The Office Action then concedes that Collard fails to teach that the item which has been already set is distinguishable from the item which has not yet been set, and asserts that Bleizeffer allegedly discloses this feature. Appellants respectfully disagree with these assertions.

a) **Bleizeffer Not Analogous to Collard**

Collard is directed to a digital image reproduction apparatus that has a display as shown in Fig. 4 for setting parameters. In particular, Collard discloses in Fig. 4 a menu screen in which the user sets parameters for reproducing digital images. Collard merely discloses an item that is being set is displayed differently. Collard does not teach that (1) an item already set, (2) an item being set, and (3) an item not yet set are displayed in a single frame and distinguishable from one another. In fact, the Office Action acknowledges this and relies on Bleizeffer for deficiencies.

Bleizeffer, on the other hand, is directed to a method and apparatus for compensating for deficiencies existing in programs to assist a user through installing a program. See Abstract of Bleizeffer. Bleizeffer provides a solution to a problem in installing a complex program on mainframe computers where only little information is given as to the interrelationship between series of tasks to accomplish, the status of various subtasks which comprises the overall tasks, or the overall relationship of the various subtasks to each other and the task as a whole. See col. 1, lines 52-63 of Bleizeffer. Bleizeffer is not related to setting of item parameters or display thereof and is instead only concerned with displaying status information. Bleizeffer provides the solution by providing an indication to a user of a workstation as steps of a task have been completed. See col. 2, lines 47-61 of Bleizeffer.

Bleizeffer does not recognize a problem in, or provide a solution to the problem in, a menu screen of a digital image reproduction apparatus as taught by Collard during the item setting. Therefore, Bleizeffer and Collard are not in the same field of endeavor as they do not

involve the same problems. As such, Bliezeffer is non-analogous to Collard. Thus, those skilled in the art in the field of a menu screen of a digital image reproduction apparatus or item setting would not have looked to or considered the teaching of Bleizeffer as a solution to the problem in the menu screen. The Office Action fails to provide a reasonable rationale that would have led one of ordinary skill in the art to the non-analogous teachings of Bleizeffer. Accordingly, those skilled in the art would not have been motivated to combine Collard and Bleizeffer as alleged.

b) **Combination Based on Impermissible Hindsight Knowledge**

Bleizeffer only displays the completed tasks with text field and the incomplete tasks without the text field. Bleizeffer does not teach or suggest distinguishably displaying items being set along with parameters to choose from. Therefore, neither Collard nor Bleizeffer reasonably teach or suggest display of 1) an item which has been already set, 2) an item which is being set along with parameters to choose from, and 3) an item which has not yet been set are displayed in the single frame of the display device so as to be distinguishable from one another, as recited in independent claims 1, 7, 13, 14, 16, 18, 20 and 22.

Therefore, about a sufficient rationale from the teachings themselves, the combination of Collard and Bleizeffer can only be a product based on impermissible hindsight knowledge gained from Appellants' disclosure. This is improper. Moreover, even if combined, the combination fails to teach each and every claimed feature and the Office Action has failed to explain a rationale for the further modification or combination to resolve such deficiencies.

At least for these reasons, Appellants respectfully submit that claims 1, 7, 13, 14, 16, 18, 20 and 22 are patentable over Collard and Bleizeffer.

Dependent claims 4-6, 10-12, 17,18 and 21 are allowable at least for their dependence on the allowable claims, as well as for the additional features they recite. Thus, withdrawal of the rejection is respectfully requested.

II. Rejections of claims 3, 9, 15 and 19

The Office Action rejects claims 3 and 9 under 35 U.S.C. §103(a) over Collard in view of Bleizeffer and further in view of U.S. Patent No. 5,543,857 to Wehmeyer; and rejects claims 15 and 19 under 35 U.S.C. §103(a) over Collard in view of Bleizeffer and further in view of U.S. Patent No. 5,751,953 to Shiels. These rejections are respectfully traversed.

Neither Wehmeyer nor Shiels overcome the deficiencies of Collard and Bleizeffer with respect to claims 1, 7, 14 and 18. Therefore, claims 3, 9, 15 and 19 are allowable at least for their dependence to claims 1, 7, 14 and 18, respectively, as well as for the additional features they recite. Withdrawal of the rejection is respectfully requested.

III. Conclusion

In view of the foregoing, Appellants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-7 and 9-22 are earnestly solicited.